

REMARKS

In response to the Office Action dated October 29, 2004, Applicants respectfully request reconsideration based on the above claim amendment and the following remarks. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 112

Claims 1 and 9 were rejected under 35 U.S.C. § 112, second paragraph. Particularly, the Examiner states that the claims fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 9 have been amended and withdrawal of the rejection under 35 U.S.C. § 112 is respectfully requested, as the rejection is now moot.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 5, and 8-11 were rejected under 35 U.S.C. § 102(b) as being anticipated by Park et al., US Patent Number 6,490,455 (hereinafter "Park") for the reasons stated on pages 2-3 of the Office Action. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the * * * claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claim 1 recites a wireless terminal locator comprising, in pertinent part, "a processor operable for instructing the transmitter to selectively page an identified wireless terminal to cause the identified wireless terminal to emit an audible ring and to reveal a location of the identified wireless terminal inside the area." Park fails to disclose at least this feature.

Park discloses an apparatus for detecting a mobile phone in an idle state wherein the mobile phone signal is detected by the detection apparatus, and an alarm is sounded to indicate that the mobile phone has not been turned off in the restricted area. Park discloses detecting the presence of a mobile phone in a restricted area by tricking the

mobile phone into transmitting a location registration signal when it enters a specific detection area. The location registration signal is not an audible ring. The system of Park only detects a mobile phone in a specific area, and directs antenna 350 in a narrow beam that points to a restricted area. If a mobile phone transmits a location registration signal, an alarm unit 500 generates an alarm. The mobile phone in Park does not emit an audible ring as recited in amended claim 1.

Thus, Park does not disclose or teach all of the elements of claim 1. Claim 8-10, as amended, recite similar features as claim 1 and are considered allowable for at least the same reasons. Claims 5 and 11 depend from claims 1 and 10, respectively, and are believed to be allowable for at least the same reasons.

Claim Rejections Under 35 U.S.C. § 103

Claims 2-4, 6, and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Park in view of Edstam, US Patent Number 6,718,175 (hereinafter "Edstam") for the reasons stated on pages 4-5 of the Office Action. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 2-4, 6, and 7 are believed to be patentable over Park in view of Edstam, at least because neither Park nor Edstam disclose a wireless terminal locator that selectively pages an identified wireless terminal to cause the identified wireless terminal to emit an audible ring and to reveal a location of the identified wireless terminal inside the area. Claims 2-4, 6 and 7 depend from claim 1. As explained above, Park does not teach or suggest all of the features of claim 1. Moreover, Edstam does not cure the deficiencies of Park because in Edstam there is no teaching or suggestion of selectively paging an

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identified wireless terminal to cause the identified wireless terminal to emit an audible ring and to reveal a location of the identified wireless terminal inside the area, as claimed in claim 1. Thus, claims 2-4, 6, and 7 are believed to be allowable over any combination of Park and Edstam.

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Park in view of da Silva, US Patent Number 6,496,703 (hereinafter "da Silva") for the reasons stated on page 5 of the Office Action.

Claims 12-14 are believed to be patentable over Park in view of da Silva, at least because neither Park nor da Silva disclose selectively paging the identified wireless terminal to cause the identified wireless terminal to emit an audible ring and audibly reveal a location of the wireless terminal inside the area, as claimed in claim 10. Claims 12-14 depend from claim 10. As explained above, Park does not teach or suggest all of the features of claim 10. Moreover, da Silva does not cure the deficiencies of Park because in da Silva there is no teaching or suggestion of selectively paging the identified wireless terminal to cause the identified wireless terminal to emit an audible ring and audibly reveal a location of the wireless terminal inside the area, as claimed in claim 10. Thus, claims 12-14 are believed to be allowable over any combination of Park and da Silva.

Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

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In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

Respectfully submitted,

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